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**OFFICE OF PETITIONS
A/C PATENTS**

In re Application of: Ramanujan et al.
Filing Date: April 12, 1993
Application Number: 08/ 047,164
For: High Speed Bus System

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ON PETITION
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This is a decision on the petitions, filed June 26, 1997, under 37 C.F.R. §§ 1.183 to waive the one year filing requirement in 37 CFR 1.137(b) and to revive the above-identified application.

The petitions are dismissed.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §§ 1.183 and 1.137(b)."

This application became abandoned for failure to time respond to the final Office action mailed June 30, 1994. Petitioners filed a response under 37 C.F.R. §1.116(a) through the assignee, Digital Equipment Corporation (DEC), with a request for a two month extension time under 37 C.F.R. §1.136(a) and Certificate of Mailing under 37 C.F.R. §1.8 dated November 30, 1994. This response was received in the PTO December 2, 1994. An Advisory Action was mailed on December 22, 1994 to the correspondence address of record which advised petitioners that the response had been considered but did not place the application in condition for allowance and would not be entered on appeal. No further communication was received from petitioners. The date of abandonment of this application is December 1, 1994, not February 1, 1995 as stated in the petition. A Notice of Abandonment was mailed on February 1, 1995

The petition to revive was not filed within one year of the abandonment date of the instant application as required by 37 CFR 1.137(b). It is strictly due to petitioners', and counsel for petitioners', delay that this application is now a long-abandoned application. Waiver of the § 1.137(b) time limit under § 1.183 for revival of unintentionally abandoned applications has been specifically limited in order to prevent the revival of long-abandoned applications. In re Fischer, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988). The showing of record does not warrant waiver of the one year time period of the regulation.

There is no showing that the abandonment of this application or the belated filing of any petition to revive were caused or contributed by circumstances beyond petitioners' or petitioners' voluntarily chosen representatives' control. Thus, in weighing petitioners' and/or petitioners' voluntarily chosen representatives' contribution to petitioners failure to realize the abandoned status of this application against any other contributing factor, waiver of the one year filing requirement of 37 CFR 1.137(b) pursuant to 37 CFR 1.183 in this situation is not justified. Petitioners are advised that delay resulting from the inadvertence or mistake of petitioners, does not warrant equitable tolling of the time period of 37 CFR 1.137(b). Equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable due care and diligence. U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983).

The final Office Action mailed June 30, 1994 was received by petitioners' representatives, Kenyon & Kenyon, and reported to the assignee DEC. In a communication dated September 7, 1994, Mr. Maloney advised Kenyon & Kenyon that (Exhibit A):

"Digital has elected to handle this matter directly. Therefore, all correspondence...should be forwarded directly to Digital at the above address. Digital will file a change of correspondence address form in the U.S.P.T.O."

On November 30, 1994 a response was appropriately submitted under §1.116(a) with a request for a two month extension of time. In that the response was filed under the rule for amendments after final demonstrates that petitioners were aware of the status and should have been aware that the mere filing of a response would not operate to relieve the application from its condition as subject to appeal or to save the application from abandonment. 37 C.F.R. §1.116(a). Petitioner's knowledge of the status of the application is further underscored by their concluding statement in the response which stated the amendment placed the application in better form for appeal. It is noted, however, that no change of correspondence was received with the amendment. In this regard the question arises, which must be answered in any renewed petition with documentary evidence, just what arrangements DEC made and how did DEC docket the application after informing Kenyon & Kenyon that DEC would handle the matter internally? Clarification is required.

The Advisory Action and subsequent Notice of Abandonment were duly mailed to petitioners' representatives at the correspondence address of record. The petition asserts that the docketing personnel at Kenyon & Kenyon did not forward either of these communications to Digital because the file (Exhibit B) had been marked "Client Will Handle." The file contains a notation for receipt of the Advisory Action but no explicit notation for the Notice of Abandonment. This raises the question of what actually happened to the Notice of Abandonment. Petitioners' representatives have not alleged non-receipt of the Notice, just that it was not forwarded to DEC. Accordingly, any renewed petition should provide verified statement from any person with first hand knowledge of the facts surrounding the handling of the Notice of Abandonment and Advisory Action.

In any event, the undue delay from December 1994, until June 1997, resulting from an apparent lack of diligence on the part of petitioners, and counsel for petitioners, is not seen to warrant equitable tolling of the one year period set forth in 37 CFR 1.137(b). See, Vincent v. Mossinghoff, 230 USPQ 621, 625 (D.D.C. 1985). Petitioners have made no attempt to explain their two and one-half year delay in again considering this application, much less the delay in filing any communication with respect to this application. The Office, where it has the power to do so, should not relax the requirements of established practice in order to save an applicant from the consequence of his delay. See Ex parte Sassin, 1906 Dec. Comm'r Pat. 205, 206 (Comm'r Pat. 1906) and compare Ziegler v. Baxter v. Natta, 159 USPQ 378 379 (Comm'r Pat. 1968) and Williams v. The Five Platters, Inc., 510 F.2d 963, 184 USPQ 744 (CCPA 1975).

Thus, there is no adequate showing of "an extraordinary situation" in which "justice requires" suspension of the time period set forth in 37 CFR 1.316(c). See, Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require waiver of the rules, when a party makes an avoidable mistake in filing papers). Circumstances resulting from petitioners', or petitioners' counsel's, failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. See, In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc. 195 USPQ 586, 588 (Comm'r Pats. 1977). The petition to waive the one year time period of 37 CFR 1.137(b) is dismissed.

A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay during prosecution and the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioners intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

37 CFR 1.137(b)(3) provides in pertinent part:

"The Commissioner may require additional information where there is a question whether the delay was unintentional."

This same provision also applies in the new rules published in the Federal Register Vol. 62, No. 197, pages 53132-53206, and in the Official Gazette of the Patent Office at 1203 O. G. 63 (October 21, 1997); effective date December 1, 1997. Clearly, when there is a two and one-half (2½) year delay in taking any further action with respect to an application, that delay raises the question as to whether the delay was unintentional. Any renewed petition under the "unintentional" standard should include such documentary evidence as would establish petitioners' *continuing* intent to prosecute the invention represented by this application. Such evidence would include, but is not limited to, ongoing foreign patent activity for the instant

subject matter, including issuance of other patents in this family, payment of foreign patent taxes or maintenance fees, sales, licences, etc., that would offset any inference that petitioners were only spurred into renewed activity with respect to this application as a result of the activity(s), or successes, of competitors. Copies of any correspondence between petitioners and/or DEC and counsel relating to this application during the period of abandonment, until the filing of this petition, are required.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: One Crystal Park, Suite 520
2011 Crystal Drive
Arlington, VA

Telephone inquiries relative to this decision should be directed to Howard Williams at (703) 308-6713 or the Office of Petitions staff at (703) 305-9282.



Abraham Hershkovitz
Director, Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects